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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL D. BULLOCK
and JEFFREY G. BULLOCK

Appeal 2008-1466
Application 09/735,002
Technology Center 1700

Decided: February 29, 2008

Before BRADLEY R. GARRIS, CHARLES F. WARREN, and
THOMAS A. WALTZ, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Primary Examiner's final rejection of claims 1-7, 9-15, and 17-19, which are the only claims pending in this application (Br. 1).¹ We have jurisdiction pursuant to 35 U.S.C. § 6(b).

¹ We refer to and cite from the Brief dated Jan. 25, 2006.

According to Appellants, the invention is directed to a putter comprising a shaft and a grip, with a putter head comprising a unitary body with a front surface having a relatively small, centrally-located, flat ball contact surface, lateral portions that taper rearwardly away from the ball contact surface, a base extending toward the rear end of the body, and a cavity formed behind the ball contact surface and above the base (Br. 1-2). Independent claims 1, 18, and 19 are illustrative of the invention and a copy of these claims is reproduced below:

1. A putter comprising:

a shaft having a grip disposed at an upper end;

a putter head disposed at a lower end of the shaft that comprises:

a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface that extends the full height of the body and that comprises a sweet spot of the putter head and lateral portions that taper rearwardly away from the ball contact surface, a base extending toward a rear end of the body, and a cavity formed behind the ball contact surface and lateral portions and above the base.

18. A putter comprising:

a shaft having a grip disposed at an upper end;

a putter head disposed at a lower end of the shaft that comprises:

a single, solid, unitary body having a front surface with a relatively small, centrally-located flat ball contact surface extending substantially the full height of the body that comprises a sweet spot of the putter head that is

about 5/8 to 1/2 inches in width and lateral portions that taper rearwardly away from the ball contact surface.

19. A putter head comprising:

a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface extending substantially the full height of the body that comprises a sweet spot of the putter head that is about 5/8 to 1/2 inches in width and lateral portions that taper rearwardly away from the ball contact surface

The Examiner has relied on the following prior art references as evidence of unpatentability:

Cicero	US Des. 226,526	Mar. 20, 1973
Swash	US Des. 234,962	Apr. 22, 1975
Mattingly	US Des. 282,952	Mar. 11, 1986
Holladay	US 5,769,737	Jun. 23, 1998

ISSUES ON APPEAL

Claim 19 stands rejected under 35 U.S.C. § 102(b) as anticipated by Cicero (Ans. 3).²

Claim 18 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Cicero (Ans. 4). Claims 1-7, 9-15, and 17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Mattingly in view of Holladay and Swash (Ans. 4).

Appellants contend that Cicero does not disclose or suggest a putter head having a ball contact surface about 5/8 to 1/2 inches in width, nor does

² We refer to and cite from the “**SUPPLEMENTAL EXAMINER’S ANSWER**” dated Oct. 31, 2007.

the front surface of the putter head of Cicero “taper rearwardly” away from the ball contact surface as required by the claims on appeal (Br. 3).

Appellants contend that the putter head disclosed by Mattingly is solid, and there is no teaching in this reference that a cavity would be desirable (Br. 4-6). Appellants contend that both Swash and Holladay disclose putters for use in a round of golf, not practice putters as claimed (Br. 5). Appellants further contend that the ball contact surface of Mattingly is not “relatively small,” any cavity in Mattingly’s putter would eliminate the alignment line required by the reference, and no base is disclosed or suggested by Mattingly (Br. 6-7).

Appellants also present contentions regarding claims 3 and 11 (an offset shaft) and claims 6 and 14 (curved surfaces) (Br. 8).

The Examiner contends that Cicero discloses a putter head where the sweet spot is about 5/8 to 1/2 inches in width with lateral portions that taper rearwardly away from the ball contact surface (Ans. 3 and 6). With regard to claim 18, the Examiner contends that it was conventional and well known in the art to provide a shaft with a grip to attach to a putter head (Ans. 4).

The Examiner contends that Mattingly shows all limitations of the claims except for a cavity, and that both Swash and Holladay teach providing a rear cavity in a putter head to reduce the overall weight of the putter by removing unnecessary weight (Ans. 5). With regard to the alleged “alignment” feature of Mattingly, the Examiner contends that there is no suggestion that this line in Mattingly is a required alignment feature (Ans. 8).

Accordingly, we determine the following issues presented from the record in this appeal: (1) Have Appellants established that the Examiner reversibly erred in determining that Cicero describes the putter head as recited in claim 19; and (2) Have Appellants established that the Examiner committed reversible error in combining Mattingly with the teachings of Swash and Holladay as proposed by the Examiner?

We determine that the Examiner has not established a *prima facie* case of anticipation with regard to claim 19 on appeal essentially for the reasons stated in the Brief, as well as those reasons set forth below. Accordingly, we REVERSE the rejection of claim 19 under § 102(b) over Cicero. Since the rejection of claim 18 under § 103(a) over Cicero involves the same issues but includes the conventionality of adding a shaft to the putter head, we also REVERSE this rejection for the same reasons. We determine that the Examiner has established a *prima facie* case of obviousness in view of the reference evidence to Mattingly, Swash, and Holladay, essentially for the reasons stated in the Answer as well as those reasons set forth below. We also determine that this *prima facie* case of obviousness has not been adequately rebutted by Appellants' arguments. Therefore, we AFFIRM the rejection of claims 1-7, 9-15, and 17 under § 103(a) over Mattingly in view of Swash and Holladay. Accordingly, the decision of the Examiner is AFFIRMED-IN-PART.

OPINION

A. The Rejections over Cicero

Claim 18 stands rejected under 35 U.S.C. § 102(b) as anticipated by Cicero (Ans. 3). “Under 35 USC 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim. *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990).” *Gechter v. Davidson*, 116 F.3d 1454, 1457 (Fed. Cir. 1997). It is well settled that the initial burden of proof rests with the Examiner to establish a prima facie case of unpatentability. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

On the record in this appeal, we determine that the Examiner has not met the initial burden of establishing a prima facie case of anticipation by the appropriate factual findings. The Examiner merely refers to Fig. 1 of Cicero and then reiterates the language of claim 19 on appeal (Ans. 3). We determine that the Examiner has failed to state where the limitation of claim 19 that the sweet spot is “about 5/8 to 1/2 inches in width” can be found in Fig. 1 of Cicero (Ans. 3 and 6-7). If the Examiner is attempting to use actual measurements from Fig. 1 of Cicero, we must note that it is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the Specification is completely silent on the issue. *See Nystrom v. Trex Co.*, 374 F.3d 1105, 1116-17 (Fed. Cir. 2004). Additionally, we note that the Examiner has not explained which surface of the putter head in Fig. 1 is relied upon as the “relatively small, centrally-located, flat ball contact surface,” especially in view of Fig. 2 of Cicero which shows the “front striking surface” to be the left surface. Accordingly, we determine that the Examiner has failed to meet

the initial burden of showing where every limitation of the claim may be found identically in the prior art reference. Therefore, we cannot sustain the rejection of claim 19 under § 102(b) over Cicero.

Claim 18 on appeal recites the same language as claim 19 but adds a shaft with grip to the putter head. The Examiner has rejected this claim under § 103(a) over Cicero for the same reasons as stated for the rejection of claim 19, additionally noting the conventionality of adding a shaft and grip to a putter head (Ans. 4 and 7). Accordingly, we determine the same deficiency in this rejection as discussed above for the rejection of claim 19. Additionally, we note that the Examiner has not proposed or explained any reason for modifying the disclosure of Cicero to meet the claimed limitations. Therefore, we also cannot sustain the rejection of claim 18 under § 103(a) over Cicero.

B. The Rejection over Mattingly, Swash, and Holladay³

We determine the following Factual Findings (FF) from the record in this appeal:

- (1) Mattingly discloses a putter head comprising a single, solid, unitary body having a front surface surface with a relatively small, centrally located, flat ball contacting surface that extends the full height of the body, and includes a sweet

³ As discussed above, Appellants do not present arguments specific to any one claim other than the groups of claims 3 and 11 and claims 6 and 14 (Br. 8). Therefore, we select the broadest independent claim (claim 1) from the rejected claims and limit our discussion to this claim and representative claims 3 and 6.

spot, lateral portions that taper rearwardly away from the ball contacting surface, and a base (Ans. 4-5; Mattingly, Figs. 3 and 5);

- (2) Swash discloses a putter head having two separate cavities behind the ball contacting surface and above the base, with holes in the putter head for attachment to a shaft for either right or left-handed players (Ans. 5; Swash, Figs. 2, 3, 7, and 8);
- (3) Holladay discloses a putter head with a cavity 17 behind the ball contacting surface and above the base, the club head being attached to a golf club shaft, where the cavity reduces the overall weight of the club head while providing sufficient structure for the striking surface (Ans. 5; Holladay, col. 2, ll. 10-14 and 25-28; col. 3, ll. 12-14 and 46-50);
- (4) Appellants admit that the grip and shaft attached to a putter head are conventional in the art (Specification 3:31); and
- (5) Appellants admit that it was conventional in the art to design putter heads consistent with overall weight concerns, such as use of a cavity in the rear portion of the putter head to reduce the overall weight (Specification 4:4-9).⁴

⁴ It is axiomatic that admitted prior art in an applicant's specification may be used in determining the patentability of a claimed invention (*In re Nomiya*, 509 F.2d 566, 570-71 (CCPA 1975)); and that consideration of the prior art cited by the Examiner may include consideration of the admitted prior art

Under 35 U.S.C. § 103, the factual inquiry into obviousness requires a determination of: (1) the scope and content of the prior art; (2) the differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) secondary considerations, if any. *See Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). “[W]hen a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740 (2007).

Applying the preceding legal principles to the Factual Findings from the record presented in this appeal, we determine that the Examiner has established a prima facie case of obviousness, which prima facie case has not been adequately rebutted by Appellants’ arguments. As shown by FF (1) listed above, we determine that Mattingly discloses every limitation of the claim 1 putter except for the shaft, grip, and the cavity formed behind the ball contact surface and above the base. As shown by FF (2), (3), and (4) listed above, we determine that it was well known and conventional in this art to attach a putter head to a shaft (either right- or left-handed) with a grip. As shown by FF (2), (3), and (5) listed above, we determine that it was well known and conventional in this art to design a cavity behind the ball contacting surface and above the base of a putter head to reduce the overall weight of the club.

found in an applicant’s specification (*In re Davis*, 305 F.2d 501, 503 (CCPA 1962); *cf.*, *In re Hedges*, 783 F.2d 1038, 1039-40 (Fed. Cir. 1986)).

Appellants argue that both Swash and Holladay disclose putters for use in a round of golf, not a practice putter (Br. 5). This argument is not well taken since it is not commensurate with the claims, nor is there any basis for Appellants' allegation that one putter head is for a round of golf while another is a practice putter.

Appellants argue that there is no teaching in Mattingly that it would be desirable to have a cavity in the rear portion of the putter (Br. 5 and 6). We agree. However, as Appellants admit (FF (5) listed above), and as evidenced by Swash and Holladay (FF (2) and (3) listed above), it was known in this art that it was desirable to form a cavity behind the ball contacting surface and above the base to reduce overall weight concerns by eliminating unnecessary weight. Therefore, we determine that it would have been obvious to one of ordinary skill in this art to form such a cavity in the putter head of Mattingly for the well known benefits.

Appellants argue that the ball contact surface of Mattingly is not "relatively small," a cavity would eliminate the alignment line required by Mattingly, and no base is disclosed by Mattingly (Br. 6-7). We find these arguments unpersuasive. Appellants have not defined "relatively small" or shown how the relative size of the ball contacting surface disclosed by Mattingly differs from this term. Appellants only allege that the line in the middle of the putter head of Mattingly is an "alignment line," much less show that it is a required feature and not merely an ornamental feature. Furthermore, the combination of references as proposed by the Examiner would not necessarily eliminate this line in Mattingly (*see* the two cavities

shown by Swash). The size of any cavity is not specified in the claims on appeal. Thus even a small cavity formed behind the ball contact surface and above the base (even for attachment of a shaft) would meet the claimed cavity limitation. We note that the putter head of Mattingly, or any putter head, would necessarily have a base (*see* Figs. 1 and 4 of Mattingly).

With regard to Appellants' argument for claim 3 (and 11), we determine that offset shafts were also well known in this art (*see* FF (4) listed above; Specification 5:5-9). With regard to Appellants' argument for claim 6 (and 14), we determine that the lateral portions shown by the Figures of Mattingly are curved at least to some degree (towards the rear of the putter head), which is all that is required by this claim.

For the foregoing reasons and those stated in the Answer, we affirm the rejection of claims 1-7, 9-15, and 17 under § 103(a) over Mattingly in view of Swash and Holladay.

C. Summary

The decision of the Examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

PL initial:
sld

Appeal 2008-1466
Application 09/735,002

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